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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,731	05/30/2001	Bertrand Piot	5725.0321-02	8123
22852	7590	08/26/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			KANTAMNENI, SHOBHA	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/866,731

Applicant(s)

PIOT ET AL.

Examiner

Shobha Kantamneni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-32 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of Amendment filed on April 5, 2004. Claims 1-32 and 59 are pending.

In view of applicants response the previous rejections are withdrawn. New rejections are made.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al. (US 5,154,916).

Arraudeau (US 5,154,916) teaches a wax-based mascara composition in emulsion form comprising 10 % by weight of carnauba wax, triethanolamine stearate, keratin hydrolysate, hydroxyethylcellulose and gum in sufficient quantity of water. The composition can be in the form of oil-in-water or water-in-oil emulsions, or in the form of suspensions in a solvent medium (column 3, lines 45-49). The waxes used in the invention possess a melting point of between 60 °C and 110 °C and have a needle penetration of 3 to 40. The waxes used are selected from among animal waxes, mineral waxes, synthetic waxes, vegetable waxes and various fractions of natural waxes etc. Among vegetable waxes Carnauba waxes, Candelilla waxes, sugarcane waxes (melting

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point 77 °C –82 °C), Ouricurry waxes (melting point 79 °C - 84 °C) are mentioned. See column 2, lines 35-61 and examples 4, 5; instant claims 1-5, 7-17, and 25-28. Mascaras are also known which are based on waxes and anionic and cationic polymers. See column 1, lines 31-32; instant claims 18-24. The composition can contain ingredients such as softeners, thickeners, preservatives, silicones and polymers. See column 5, lines 18-25; instant claims 29, 32.

Arraudeau reference (US 5,154,916) fails to specifically point out the particle size of the wax. However, they use the same method to make mascara compositions in emulsion form. See column 6, lines 43-51. It would have been obvious to make the mascara composition in emulsion form with particle size of the wax 1 µm or greater by using similar waxes and same method with the motivation of using the resulting compositions for curling and/or thickening keratin fibers.

Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,154,916 as applied to claims 1-5, 7-29 and 32 above, and further in view of Arraudeau et al. (US 4,871,536).

Arraudeau reference (US 5,154,916) fails to specifically teach dimethicone copolyol as silicone surfactant. Arraudeau (US 4,871, 536) teaches a mascara composition comprising use of cationic polymers and waxes. Cationic silicone polymers such as AMODIMETHICONE are mentioned. See column 8, lines 66-69; instant claims 30-31.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make mascara composition comprising silicones as

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taught by Arraudeau (US 5,154,916). By specifically using dimethicone copolyol having an HLB ranging from 8 to 16 as silicone surfactant, a composition with improved pigment distribution and greater stability will be obtained. The motivation would be to obtain a wax-in-water mascara composition for curling and/or thickening keratin fibers.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-32 and 59 have been considered but are not persuasive.

Arraudeau (US 5,154, 916) discloses a wax-based mascara composition comprising 10 % by weight of carnauba wax, triethanolamine stearate, hydroxyethylcellulose, keratin hydrolysate and sufficient quantity of water. See Example 5 in Arraudeau. Arraudeau also teach the method of making the mascara compositions in emulsion form. See column 6, lines 43-51. It is obvious from Example 4 that the mascara composition is a wax-in-water composition. The applicants argument regarding, the wax particle size of atleast 1  $\mu\text{m}$  or greater is not persuasive. Since Arraudeau uses the same waxes and same method to make mascara composition as the instant invention, he would have obtained the composition with wax particle size of 1  $\mu\text{m}$  or greater.

In response to the arguments regarding the Jeffcoat, Mizuno and Leis references, the examiner used Jeffcoat reference to show that triethanolamine stearate is well know in the art as an emulsifier for oil-in-water emulsions. Mizuno reference was

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used to show that carnauba wax powder having a particle size of less than 80 mesh is used in cosmetic art for example cosmetic stick.

***Allowable Subject Matter***

Claim 59 is allowed.

Claim 6, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Claim 59 is allowed.

Claim 6 is objected to.

Claims 1-5 and 7-32 are rejected.

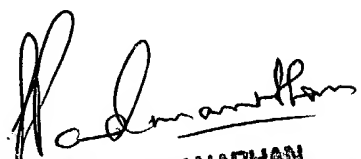
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on 8 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**